



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/226,107	01/07/1999	YASUNORI WATANABE	102491	1509

25944 7590 12/29/2003

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 12/29/2003

91

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/226,107

Applicant(s)

WATANABE ET AL.

Examiner

Joseph R. Pokrzywa

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-29 is/are allowed.
- 6) ☒ Claim(s) 1-11, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 12-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 21
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendments

1. Applicant's amendments were received on 10/22/03 and 10/29/03, and have been entered and made of record. Currently, **claims 1-29** are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-5, 7, 21, and 22** are rejected under 35 U.S.C. 102(e) as being anticipated by Takano *et al.* (U.S. Patent Number 6,078,765).

Regarding **claim 1**, Takano discloses a multi-functional device (see Figs. 1-4) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (see Fig. 2), a shaft supported on the outer casing (fulcrum A, column 6, lines 46 through 55), a recording section that records images on a recording medium (recording portion 4), and a reading section that reads images from a document (reading portion 3), with the reading section having a front edge substantially in coincidence with the front side of the outer casing (see Fig. 1), a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft (see Figs. 1 and 3), wherein when

Art Unit: 2622

the reading section pivots away from the recording section such that the front edge moves forward and downward (see Fig. 3), a space is provided above the recording section (seen in Fig. 3), and the recording section is exposed outside through the space (seen in Fig. 3, column 6, line 56 through column 7, line 20), and a control panel (operation portion 25) having a front end substantially in coincidence with the front side of the outer casing (see Figs. 2-4), a rear end opposing the front end, and a lower surface (see Figs. 2-4), wherein the reading section is disposed on the lower surface of the control panel (see Fig. 1) and pivotable together with the control panel, wherein the control panel faces frontward when the space is defined above the recording section (see Fig. 3).

Regarding *claim 2*, Takano discloses the device discussed above in claim 1, and further teaches that the reading section is disposed closer to the front side of the outer casing than the recording section (see Fig. 1) and is pivotable toward the front side of the outer casing (see Figs. 1 and 3).

Regarding *claim 3*, Takano discloses the device discussed above in claim 1, and further teaches that the shaft (fulcrum A) is disposed adjacent to the recording section and disposed nearer the front side of the outer casing than the recording section (see Figs. 1 and 3).

Regarding *claim 4*, Takano discloses the device discussed above in claim 1, and further teaches that the reading section is pivotable together with the control panel, such that the front end of the control panel moves downward (see Figs. 1-3).

Regarding *claim 5*, Takano discloses the device discussed above in claim 4, and further teaches of a document holding section that extends from the rear end of the control panel for supporting documents to be conveyed to the reading section (board 2C and sheet tray 2b, column

Art Unit: 2622

5, lines 8 through 21), wherein the document holding section moves together with the reading section, and serves as a cover for covering the recording section when not moved open (see Figs. 1-3).

Regarding *claim 7*, Takano discloses the device discussed above in claim 1, and further teaches that the reading section is disposed adjacent to the recording section and covers at least a portion of the recording section (see Figs. 1 and 3).

Regarding *claim 21*, Takano discloses a multi-functional device (see Figs. 1-4) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (see Fig. 2), a shaft supported on the outer casing (fulcrum A, column 6, lines 46 through 55), a recording section that records images on a recording medium (recording portion 4), a reading section that reads images from a document (reading portion 3), with the reading section having a front edge substantially in coincidence with the front side of the outer casing (see Fig. 1), a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft in a manner that the front edge moves forward and downward so as to separate from the recording section (see Figs. 1 and 3), whereby a space is provided above the recording section (seen in Fig. 3, column 6, line 56 through column 7, line 20), and a control panel (operation portion 25) having a front end substantially in coincidence with the front side of the outer casing (see Figs. 2-4), a rear end opposing the front end, and a lower surface (see Figs. 2-4), wherein the reading section is disposed on the lower surface of the control panel (see Fig. 1) and pivotable together with the control panel, wherein the control panel faces frontward when the space is defined above the recording section (see Fig. 3).

Regarding *claim 22*, Takano discloses a multi-functional device (see Figs. 1-4) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (see Fig. 2), a shaft supported on the outer casing (fulcrum A, column 6, lines 46 through 55), a recording section that records images on a recording medium (recording portion 4), a reading section that reads images from a document (reading portion 3), with the reading section having a front edge substantially in coincidence with the front side of the outer casing (see Fig. 1), a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft (see Figs. 1 and 3), wherein when the reading section pivots away from the recording section, a space is provided above the recording section (seen in Fig. 3), and the recording section is exposed outside through the space (seen in Fig. 3, column 6, line 56 through column 7, line 20), wherein the shaft is located approximately halfway between the front edge and the back edge (see Figs. 1 and 3), and when the reading section pivots away from the recording section, the front edge moves to a position below the shaft (see Fig. 3), and a control panel (operation portion 25) having a front end substantially in coincidence with the front side of the outer casing (see Figs. 2-4), a rear end opposing the front end, and a lower surface (see Figs. 2-4), wherein the reading section is disposed on the lower surface of the control panel (see Fig. 1) and pivotable together with the control panel, wherein the control panel faces frontward when the space is defined above the recording section (see Fig. 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Takano *et al.* (U.S. Patent Number 6,078,765) in view of Saito *et al.* (U.S. Patent Number 5,826,133, cited in the Office action dated 5/5/03).

Regarding **claim 6**, Takano discloses the device discussed above in claim 1, and further teaches that the recording section is provided with an ink cartridge that can be upwardly removed from the printer after pivoting the reading section away from the recording section (column 5, lines 39 through 62, and column 8, line 47 through column 9, line 12). However, Takano fails to specifically teach if the recording section comprises an ink-jet printer. Saito discloses a device that comprises a reading section (304, column 9, lines 62 through 67) and a recording section (305, column 10, lines 1 through 7) whereby the recording section comprises an ink-jet printer (column 11, lines 45 through 57) provided with an ink cartridge that can be upwardly removed from the ink-jet printer after pivoting a section away from the recording section (column 5, lines 37 through 52). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Saito's teachings in the system of Takano. Takano's system would easily be modified with the teachings of Saito, as the systems share cumulative features, being additive in nature.

6. **Claims 8-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano *et al.* (U.S. Patent Number 6,078,765) in view of Tanoue *et al.* (U.S. Patent Number 5,884,117, cited in the Office action dated 5/5/03).

Regarding **claim 8**, Takano discloses the device discussed above in claim 4, and further teaches of a document discharge tray pivotally and detachably mounted near the front edge of the reading section for receiving documents discharged from the reading section (sheet discharge tray 8), wherein the document discharge tray is maintained at a predetermined angle with respect to a direction in which the documents are discharged when in use (see Fig. 1).

However, since Takano teaches that the document discharge tray (sheet discharge tray 8) being a drawer type (column 6, lines 33 through 42), Takano fails to particularly teach if the document discharge tray is pivotable in a direction opposite the pivoting direction of the reading section. Tanoue discloses a multi-functional device (column 1, lines 8 through 15) comprising an outer casing having a front side, a rear side opposing the front side, and a lower side (printer body 1, see Figs. 1 and 2), a shaft supported on the outer casing (hinge 2a, column 8, lines 12 through 19), a recording section that records images on a recording medium (process cartridge 40, column 4, line 44 through column 5, line 9), and a reading section that reads images from a document (image reading unit 90, column 4, lines 24 through 37), with the reading section having a front edge substantially in coincidence with the front side of the outer casing, a back edge opposing the front edge, left and right walls, and a lower surface (see Fig. 1), the reading section being disposed above the shaft and pivotable about the shaft (column 8, lines 12 through 19, see Figs. 1 and 2), wherein when the reading section pivots away from the recording section such that the front edge moves forward and downward (see Fig. 2, arrow D), a space is provided

Art Unit: 2622

above the recording section (large access section 1a, column 8, lines 16 through 19), and the recording section is exposed outside through the space (column 8, lines 20 through 25).

Further, Tanoue teaches of a document discharge tray pivotally and detachably mounted near the front edge of the reading section for receiving documents discharged from the reading section (face-up delivery tray 82, column 8, line 66 through column 9, line 5), wherein the document discharge tray is maintained at a predetermined angle with respect to a direction in which the documents are discharged when in use (see Figs. 1 and 6, and column 11, lines 29 through 32) and is pivotable in a direction opposite the pivoting direction of the reading section (via hinges 82a, 82b, and 82c, column 8, line 66 through column 9, line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Tanoue in the system of Takano. Takano made the design choice of using a drawer type discharge tray, but would easily be modified to incorporate Tanoue's teachings of a foldable delivery tray, since the systems share cumulative features, being additive in nature.

Regarding *claim 9*, Takano and Tanoue disclose the device discussed above in claim 8, and Tanoue further teaches of a document discharge tray mounting portion on which the document discharge tray is mounted, wherein the document discharge tray is mounted on the document discharge tray mounting portion from upward (see Figs. 1, 2, and 4, column 8, line 6 through column 9, line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Tanoue in the system of Takano. Takano made the design choice of using a drawer type discharge tray, but would easily

Art Unit: 2622

be modified to incorporate Tanoue's teachings of a foldable delivery tray, since the systems share cumulative features, being additive in nature.

Regarding *claim 10*, Takano and Tanoue disclose the device discussed above in claim 8, and Takano further teaches of a recording paper discharge tray (face-down paper discharge portion 12) having an underside, right side and a left side, with the recording paper discharge tray being provided on the front end of the outer casing for receiving recording paper discharged from the recording section (see Fig. 1), the recording paper discharge tray normally slanting upward and being displaced downward due to contact from the reading section when the reading section pivots away from the recording section (see Figs. 1 and 3).

Regarding *claim 11*, Takano and Tanoue disclose the device discussed above in claim 10, and Takano further teaches of an urging member (see Figs. 1 and 3, being the tab protruding from the back of the tray 12), wherein the recording paper discharge tray is pivotally supported on the outer casing and is supported by the urging member to slant upward (see Figs. 1 and 3).

Allowable Subject Matter

7. **Claims 12-20** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. **Claims 23-29** are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claim 12**, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the multi-function device, as claimed, include the feature of the urging member comprising a leaf spring that supports the recording paper discharge tray by contacting the underside of the recording paper discharge tray at a center between the leftside and the rightside. None of the prior art specifically teaches of this limitation, thereby containing allowable subject matter.

Regarding **claim 23**, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the multi-functional device, as claimed, include the features of having the document discharge tray initially move integrally with the pivoting movement of the reading section, and after the document discharge tray has moved integrally with the pivoting movement of the reading section for a predetermined angle, the document discharge tray pivots in a direction opposite the pivoting direction of the reading section as the reading section pivots further. The closest prior art, Tanoue *et al.* (U.S. Patent Number 5,884,117), indicated in the Office action dated 5/5/03, teaches of the document discharge tray initially moving integrally with the pivoting movement of the reading section (seen as path D in Fig. 2), but fails to teach of the document discharge tray pivoting in a direction opposite the pivoting direction of the reading

Art Unit: 2622

section as the reading section pivots further. Because of this feature, which was added in the amendment dated 10/22/03, the claim is rendered allowable.

Citation of Pertinent Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Morimoto (U.S. Patent Number 6,115,564) discloses an image forming apparatus with a pivotable scanner portion.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj